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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,360	11/29/2001	Rowan Bosworth-Davies	TN223	5529

7590 02/28/2006

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EXAMINER

PATEL, JAGDISH

ART UNIT PAPER NUMBER

3624

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/998,360	Applicant(s) BOSWORTH-DAVIES ET AL.	
	Examiner JAGDISH PATEL	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-21 is/are allowed.
- 6) ☒ Claim(s) 22-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to amendment filed 4/12/2004.

Response to Amendment

2. Claims 1, 22, 43 and 65 be amended and new claim 66-67 have been added. Claims 1-67 are currently pending.

Response to Arguments

3. Applicant's arguments with respect to rejection of claims under 35 USC 101, 112(second) and 102 rejections over Cofod have been fully considered. The amendment has overcome the prior art rejection of claims 1-43, 65 and 67, the apparatus claims 44-62 stand rejected under the prior art as previously stated. The examiner has deemed the aforementioned claims 1-21 allowable over the prior art, claims 22-43, 65 and 67 allowable subject to appropriate amendment to resolve the 112 (second) deficiencies presented in the following sections. It is noted that claims 44-62 also have been rejected under 35 USC 101 as non-functional subject matter.

Claim Rejections - 35 USC § 112

3. Claims 22-67 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 22: The indefiniteness in the aforementioned claim arises due to recitation of certain function(s) or acts only as intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the case of claim 22 for example, the step of “running the at least one transaction through a processor” recites the intended use of the running of the transaction as “to detect a potential for the presence of financial irregularity in said at least one transaction to produce an outcome (116, 124, 132) indicative of the potential..”. (emphasize added.) Note that the acts of detecting a potential and “to produce an outcome” are both mere intended functions since the intended functions are not positively recited in the method steps.
5. As a result of the foregoing deficiency, the dependent claims lack proper antecedent basis for the respective features. For example, dependent claim 23 recites “a numerical outcome is produced for each rule that is transgressed by the transaction” lacks antecedent basis for “each rule..transgressed” since claim 22 fails to positively and definitely recite necessary method step required as previously discussed.
6. The foregoing analysis also applies to independent claims 44 and 65 which also recites similar method steps.

Claim Rejections - 35 USC § 102

6. Claims 44-64 are rejected under 35 U.S.C. 102(b) as being anticipated by Cofod.

(Refer to analysis provided in office action dated 1/13/2004)

7. The examiner notes that the computer-readable medium (i.e. apparatus) claims 44-64 have not been amended consistent with the method claims 22-42. Claim 44 only recites a computer-readable medium which stores a computer-executable instructions for storing a database containing a selected transaction and running (i.e. processing) the selected transaction through a predetermined set of rules for detecting a potential for the presence of financial irregularities. Since, the applicant has not provided any remarks concerning claim 44 and in light of the aforementioned "intended use recitation, the examiner has maintained 35 USC 102 rejections of claims 44-64 over Cofod reference.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 44-65 and 67 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. Exemplary claim 44 recites a computer-readable medium (an apparatus). However, the apparatus is rendered non-functional and inoperative because there is nothing in the claimed system to impart functionality of these computer codes. Note that functionality of the computer executable codes is realized only, when they are acted upon by a processor or a computing device.

Solution: amend the claim preamble to read as follows:

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“A computer-readable medium having computer-executable instructions when acted upon by a computer performing a method steps comprising:” etc.

Allowable Subject Matter

7. Claims 1-21 are allowed. Other claims allowable subject to resolution of 112 (second) and 101 deficiencies as discussed.

Conclusion

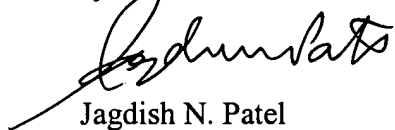
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Jagdish N. Patel", is written over the printed name.

Jagdish N. Patel

(Primary Examiner, AU 3624)

2/2/06